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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/598,336	09/25/2007	Konrad Kemper	2400.0740000/VLC/DAS	2752

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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER
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BROWN, COURTNEY A

ART UNIT	PAPER NUMBER
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1616

MAIL DATE	DELIVERY MODE
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03/31/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/598,336	<b>Applicant(s)</b> KEMPER ET AL.	
	<b>Examiner</b> COURTNEY BROWN	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3,9 and 11-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,9, and 11-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/14/2009</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Acknowledgement of Receipt/Status of Claims***

This Office Action is in response to the amendment filed January 14, 2009. Claims 3, 9, and 11-17 are pending in the application. Claims 1, 2, and 4-8 stand cancelled. Claims 3 and 9 have been amended. Claims 11-17 are newly added. Claims **3, 9, and 11-17** are being examined for patentability.

Rejections not reiterated from the previous Office Action are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set of rejections and/or objections presently being applied to the instant application.

### ***Information Disclosure Statement***

The Information Disclosure Statements (IDS) submitted on January 14, 2009 has been considered by the examiner.

### **New Rejection(s) Necessitated by the Amendment filed on January 14, 2009**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 3, 9, and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suarez-Cervieri et al. (US Patent Application 20050032903) in view of Oliveira (Proceedings VII World Soybean Research Conference, CABI abstracts) and Henn (Mississippi State University).**

***Applicant's Invention***

Applicant claims a method of protecting soya beans against soya bean rust comprising applying one or more demethylation inhibitor (DMI) fungicide, fluquinconazole, and a mixture of fluquinconazole with an active selected from prothiconazole and tolyfluanid to the seed of said plants.

***Determination of the scope and the content of the prior art  
(MPEP 2141.01)***

Suarez-Cervieri et al. teach a method for controlling rusts in legumes, which comprises treating the aerial plant part of the legumes with an aqueous preparation of a strobilurin-containing formulation (abstract). Suarez-Cervieri et al. teach that the severe incidence of rust diseases in soybean crops is caused by the harmful fungi *Phakopsora pachyrhizi* and *Phakopsora meibomia* ([0002]). Suarez-Cervieri et al. teach the use of prothioconazole ([0029]) and tolyfluanid ([0039]) as possible fungicides, combined with strobilurin-type fungicides that can be used to treat rust. Suarez-Cervieri et al. also teach the treatment of seed ([0044]).

***Ascertainment of the difference between the prior art and the claims  
(MPEP 2141.02)***

The difference between the invention of the instant application and that of Suarez-Cervieri et al. is that the instant invention claims the use of fluquinconazole combined with prothioconazole or tolyfluanid as opposed to strobilurin –type fungicides. For this reason, the teachings of Oliveria and Henn are joined. Oliveria and Henn teach

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that fluquinconazole can be used to treat soybean rust (see the abstract of Olivera and page 8 of Henn).

***Finding of prima facie obviousness***

***Rationale and Motivation (MPEP 2142-2143)***

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of the two cited references to arrive at a method of protecting soya beans against soya bean rust. Suarez-Cervieri et al. teach that the use of a triazole compound such as prothioconazole and tolylfluanid combined with strobilurin-type fungicides are effective at protecting soybean from harmful fungi such as *Phakopsora pachyrhizi* and *Phakopsora meibomia* for treating seed of soy beans against fungal plant pathogens. Olivera and Henn teach that fluquinconazole can be used to treat soybean rust. The claims of the instant invention would have been obvious because the substitution of strobilurin-type fungicides with fluquinconazole would have yielded predictable results to one of ordinary skill in the art at the time of the invention because both actives are known to protect soybeans from rust or from fungi that cause rust.

In reference to a method for protecting transgenic soybeans using a composition comprising fluquinconazole and prothioconazole or tolylfluanid, it is the Examiner's position that it is known to one of ordinary skill in the art that a fungicide that works to protect regular soybean plants will also work to protect transgenic soybeans in manner.

Therefore, the claimed invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made because every element of the invention has been fairly suggested by the cited reference.

### ***Response to Arguments***

Applicant's arguments, filed November 4, 2008, with respect to the 103 rejection of claims 1-10 under 35 U.S.C. 103(a) as being unpatentable over Suarez-Cervieri et al. (US Patent Application 20050032903) in view of Asrar et al. (US Patent 7,098,170 B2) have been considered but are moot in view of new rejections.

The claims remain rejected.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR Only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Courtney Brown, whose telephone number is 571-270-3284. The examiner can normally be reached on Monday-Friday from 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Courtney A. Brown  
Patent Examiner  
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/Mina Haghighatian/  
Primary Examiner, Art Unit 1616